

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Tuschl et al.
APPLICATION NO.: 09/821,832
FILING DATE: March 30, 2001
TITLE: RNA Sequence-Specific Mediators of RNA Interference
EXAMINER: L. V. Wollenberger
GROUP ART UNIT: 1635
ATTY. DKT. NO.: 26421-01001
CONFIRMATION NO.: 6240

MAIL STOP PETITIONS
COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 22313-1450

**RESPONSE TO PETITION TO VACATE DECISION REVOKING
POWER OF ATTORNEY UNDER 37 C.F.R. § 1.36(a)**

Dear Sir:

On September 3, 2009, the Office of Petitions granted Max-Planck's petition submitted pursuant to *In re Goldstein*, 16 USPQ2d 1963 (Comm'r Pat. 1988) ("Goldstein Petition"). It did so after carefully considering an opposition on behalf of Whitehead, M.I.T. and UMass ("Opponents").

Petitions' basis for granting Max-Planck's Goldstein Petition was clear: "Only the owner of the *entire* right, title and interest in an application has the sole right to control prosecution of an application." Page 2 (Sept. 3 grant). In their opposition, Opponents asserted that the "sole right to control the instant application is set by contract" (*id.*). Petitions appropriately refused to construe any contractual language stating: "Absent a clear determination by an appropriate authority regarding representation of the parties in the instant application, the alleged contractual agreements . . . will not determine a party's sole right to control the case. Thus, the principles set forth in *In re Goldstein* remain valid here." *Id.*

Petitions recognized that "Max-Planck and the other co-assignees have divergent interests" and thus "no one side can reasonably expect or be permitted to control the prosecution

of this application to the exclusion of others. Furthermore, denying Max-Planck the ability to choose its own counsel and requiring Max-Planck to have its interests represented by an opposing party in litigation would not be appropriate for the USPTO.” *Id.* at 2-3.

Petitions made clear that further correspondence to the USPTO “must be signed by both: (1) a registered practitioner representing Max-Planck; and (2) a registered practitioner representing the interests of the other co-assignees.” *Id.* at 3. *In spite of this admonition*, Opponents filed responses in Serial Number 09/821,832 and Serial Number 11/474,738 without the signature of “a registered practitioner representing Max-Planck.”

Now Opponents challenge Petitions’ action on another basis—the district court’s denial of Max-Planck’s motion for a preliminary injunction. At the outset, Max-Planck notes the decision was rendered early in the litigation based upon papers filed before any discovery had occurred. Moreover, the district court’s decision contains no “clear determination by an appropriate authority regarding . . . the alleged contractual agreements,” as required by Petitions.

The district court made no findings of fact, and has also not drawn any legal conclusions, regarding the interpretation of the parties’ agreements. That “clear determination” is yet to be made at trial. The Court set a very early trial date, and indicated no dispositive motions were to be filed, thus indicating that there were major factual issues to be resolved. Furthermore, the Court’s decision did not address whether it is appropriate for a single law firm to represent the interests of all of the co-assignees nor whether Max-Planck has adequate representation looking after its interests absent the Goldstein petition grant.

In any case, the bases for Petitions’ grant of Max-Planck’s Goldstein Petition remain. Opponents are not the owners of the entire right, title and interest in the subject application, and the litigation disputes between Max-Planck and Opponents are ongoing. Thus, Opponents’ petition to vacate Petitions’ grant of Max-Planck’s Goldstein petition should be denied.

Please charge any petition fee set forth in 37 C.F.R. §1.17(f), and any and all fees associated with the Response To Petition To Vacate Decision Revoking Power Of Attorney Under 37 C.F.R. § 1.36(A), to Deposit Account No.02-2135.

Respectfully submitted,

Dated: November 2, 2009

By: 

Robert B. Murray

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